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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JERRY WALTER MALCOLM and
NEWTON JAMES SMITH JR.

Appeal 2008-0796
Application 09/731,651
Technology Center 2100

Decided: September 9, 2008

Before JAMES D. THOMAS, HOWARD B. BLANKENSHIP, and ALLEN
R. MACDONALD, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-9, 11-13, 15, 16, 18-20, 22-24, and 26-30, which are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' invention relates to a system for filling out electronic forms using information previously entered into a database. (Abstract.)
Claim 1 is illustrative.

1. A method for inserting data into an electronic form having at least one field that is compliant with a standard, the method comprising:

providing a database having at least one field that is compliant with the standard, wherein at least one compliant database field may have a plurality of field values;

providing a set of rules that select one field value from each compliant database field having a plurality of field values;

applying the set of rules to select one field value from each compliant database field having a plurality of field values;

matching each compliant database field with the corresponding compliant form field; and

inserting each selected field value into the corresponding compliant form field;

wherein the standard is a protocol extension that specifies the fields that may be used in the electronic form and in the database; and

whereby a completed form is created.

The Examiner relies on the following references as evidence of unpatentability:

Higley	US 6,065,048	May 16, 2000
Maxwell	US 6,589,290 B1	Jul. 8, 2003 (filed Oct. 29, 1999)
Pennell	US 6,910,179 B1	Jun. 21, 2005 (filed Nov. 9, 1999)

Claims 1-9, 11-13, 15, 16, 18-20, 22-24, 26, 27, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Maxwell and Pennell.

Claims 28 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Maxwell, Pennell, and Higley.

In view of Appellants' arguments in the Brief, we will decide the appeal with respect to the rejection over Maxwell and Pennell on the basis of claim 1 alone. *See* 37 C.F.R. § 41.37(c)(1)(vii).

The Examiner finds that Maxwell teaches substantially all the subject matter of instant claim 1, but does not “specifically” disclose storing data within a database. The Examiner turns to Pennell for the teaching deemed to be missing from Maxwell. (Ans. 3-4.)

Appellants argue that the claimed invention “requires an electronic form having at least one field that is compliant with a *standard*.” (Br. 12.) Appellants have “clearly defined the term ‘standard’ to mean ‘a protocol extension which specifies the fields which may be used in the forms *and* in the corresponding user database,’” referring to page 5 of the Specification. (*Id.*)

“As used herein, the term compliant means adhering to a standard. As used herein, the term standard means a protocol extension which specifies the fields which may be used in the forms and in the corresponding user database.” (Spec. 5: 6-8.)

If one were to interpret instant claim 1 by the literal terms indicated in the Specification, the claim could be recast as, “[a] method for inserting data into an electronic form having at least one field that adheres to a standard with a standard,” or perhaps

[a] method for inserting data into an electronic form having at least one field that adheres to a protocol extension which specifies the fields which may be used in the forms and in the corresponding user database with a protocol extension which specifies the fields which may be used in the forms and in the corresponding user database.

The claim would also be read to mean, in its “wherein” clause, “wherein the protocol extension which specifies the fields which may be used in the forms and in the corresponding user database is a protocol extension that specifies the fields that may be used in the electronic form and in the database.”

In any event, we need not attempt to read some definition from the Specification into Claim 1 because the claim expressly recites: “wherein the standard is a protocol extension that specifies the fields that may be used in the electronic form and in the database.” The Examiner gives weight to the recitation, and finds the limitation taught at column 14, line 62 through column 15, line 32 of Maxwell. (Ans. 4.) The claim also recites the step of “matching each compliant database field with the corresponding compliant form field,” for which the Examiner also refers to Maxwell. (*Id.*)

Maxwell describes method and apparatus for populating a form with data. A data collection interface 1000 (Fig. 10) may be used to collect and store multiple data sets from multiple users. A “data set” is a collection of related information, such as payment or personal information. The collected data may be stored in secure storage medium 1010. The data stored in storage medium 1010 is utilized to populate a form when the user issues a form population command. Maxwell col. 9, ll. 37 - 61.

In our view, Maxwell’s description (e.g., Fig. 10) of placing data from fields in a data collection form into a storage medium (1010) would have at

least suggested that the data is stored in corresponding fields in a database comprising secure storage medium 1010. Perhaps in an abundance of caution, the Examiner has produced Pennell to show that the virtues of organizing data by means of a database were well known to the artisan.

In the form population phase, Maxwell searches for a template file that resembles the form to be populated with data (Fig. 5). In particular, each form description in the template file is associated with a regular expression and a list of controls. Each control has an index, a symbol, and a control type description. Maxwell col. 12, ll. 51-62. The symbol represents the data that is to be placed inside the fields of the form. The symbol may represent, for example, a name, date, or gender. Col. 12, l. 64 - col. 13, l. 14. The form completion program utilizes the template file to identify the kind of data to insert into each of the form's data receptacles. For example, the template file allows the form completion program to determine which of the data receptacles contain personal information and which contain payment information. Once the form completion program identifies what kind of data to insert into each data receptacle, the program begins to input the appropriate data into the appropriate data receptacle. Col. 14, ll. 29-41.

Maxwell describes a comprehensive example of operation of the form completion program (Fig. 7) at column 17, line 37 through column 19, line 6.

Appellants' reliance on the broad and unspecified "standard" in instant claim 1 does not persuade us of error in the Examiner's rejection. As the Examiner indicates (Ans. 11-12), Maxwell's template file constitutes a "standard," or "protocol extension," for all that claim 1 requires. The

template file specifies the fields that may be used in populating the electronic form, and specifies the fields that may be retrieved from storage to populate the form.

Appellants' only other argument in response to the rejection of claim 1 is based on the odd complaint that the Examiner has evaluated the claims "word by word." (Br. 15.) In our view, the Examiner has considered the claimed invention as a whole, showing where each of the claimed limitations are found to be taught in the prior art. Appellants' part is to show what of the "whole claimed invention" the rejection fails to consider, which Appellants have not done.

Being not persuaded of error in the rejection, we sustain the rejection of claims 1-9, 11-13, 15, 16, 18-20, 22-24, 26, 27, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Maxwell and Pennell.

Rather than addressing the Examiner's particular findings in support of the rejection of claim 28, Appellants simply allege (Br. 14) there have been none.

As the Examiner finds, Higley describes (col. 6, ll. 49-67) the standard MIME protocol. We agree with the Examiner that the artisan would have considered it obvious to use an art-recognized standard protocol for retrieving an electronic form from a server.

A person having ordinary skill in the art uses known elements for their intended purpose. *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969) (radiant-heat burner used for its intended purpose in combination with a spreader and a tamper and screed). "[W]hen a patent 'simply arranges old elements with each performing the same function it had

been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740 (2007) (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976)).

We thus sustain the rejection of claim 28 under 35 U.S.C. § 103(a) as being unpatentable over Maxwell, Pennell, and Higley. Claim 30 falls with claim 28. *See* 37 C.F.R. § 41.37(c)(1)(vii).

CONCLUSION

The rejections of claims 1-9, 11-13, 15, 16, 18-20, 22-24, and 26-30 under 35 U.S.C. § 103(a) are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

rwk

IBM CORPORATION (AUS)
c/o Rudolf O Siegesmund Yee & Associates, P.C.
P.O. Box 802333
DALLAS TX 75380